

Appl. No. 09/785,863
Amdt. dated May 23, 2005
Reply to Office Action of February 23, 2005

PATENT

REMARKS/ARGUMENTS

Claims 38 and 39 were pending in this application. No claims have been amended, added or canceled. Hence, claims 38 and 39 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claim 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,222,120 to McLeod, hereinafter "McLeod," in view of the cited portions of U.S. Patent No. 6,373,817 to Kung, *et al.* (hereinafter "Kung").

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McLeod, in view Kung, and further in view of the cited portions of U.S. Patent No. 6,311,063 to Valliani, *et al.* (hereinafter "Valliani").

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejections of claim 38 and 39 since the office action has not established a case of *prima facie* obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations.

For example, with respect to claim 1, the office action states that detecting an off-hook condition is "inherent." Without providing the required "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art" (MPEP §2112), the Office Action, merely asserts in a footnote that "many claimed featured ... are inherent." This fails to support a case of *prima facie* obviousness for several reasons. First, as just stated, the support is missing. Moreover, the limitation "detecting ... an off-hook condition" is hardly necessarily present in the cited references. For example, any of the communication networks in the cited references could

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be a mobile phone network. The concept of "off-hook" does not apply to mobile telephone networks. Mobile phones do not have dial tones. Hence, the feature "detecting ... an off-hook condition" is not inherent and claim both claims are believed to be allowable, at least for this reason.

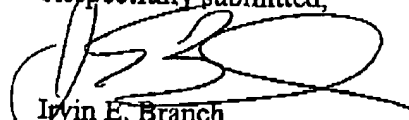
Further, with respect to claim 39, Valliani does not support the limitation "via the same subscriber line..." Valliani relates to mobile phone systems. "The same subscriber line" from the claim limitation refers to the same line from claim 38 at which an off-hook condition was detected and information services were provided in place of a dial tone. Neither of these concepts, dial tone and off-hook condition, are applicable to a mobile phone system. Hence, claim 39 is believed to be allowable for this additional reason.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
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